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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,820	10/29/2003	Makoto Kubo	244579US0	6772

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EXAMINER	
DELCOTTO, GREGORY R	

ART UNIT	PAPER NUMBER
1751	

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/694,820	KUBO ET AL.	
	Examiner	Art Unit	
	Gregory R. Del Cotto	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-6 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-6 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 3-04, 12-03.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-6 are pending.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 provides for the use of a fatty acid alkanolamide, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 5 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/46356.

'356 teaches improved modified monoethanolamide compositions wherein the modified monoethanolamide compositions, which are liquid at ambient temperatures of lower, exhibit surfactant properties substantially the same as those exhibited by diethanolamides such as foam stabilization and viscosity building as well as other desirable characteristics. See Abstract. Note that, the Examiner asserts that one of ordinary skill in the art would be motivated to formulate the claimed compound from the

disclosure of the alkanolamides taught by '356 due to the similarity in chemical structure and expectation that the claimed compounds will possess similar properties. The claims compounds are higher homologs of the compounds taught by the prior art in that they differ by only one methyl group. A rejection based on close structural similarity is founded on the expectation that compounds similar in structure will have similar properties. An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties. In re Payne, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA 1979). See MPEP 2144.09.

'356 does not teach, with sufficient specificity, a thickener comprising a fatty acid alkanolamide compound recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a fatty acid alkanolamide compound as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of '356 suggest a fatty acid alkanolamide compound as recited by the instant claims.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohn-Stocker et al (US 6,172,035), Librizzi (US 6,514,918), or EP 232,153.

Hohn-Stocker et al teach thickening agents based on fatty acid monoisopropanolamide which are etherified with ethylene oxide and/or propylene oxide, their use in surface-active formulations and formulations comprising an active amount of these thickening agents. See Abstract. Hohn-Stocker et al teach alkanolamides which

have a similar structure to those recited by the instant claims. See column 2, lines 10-20. Note that, the Examiner asserts that one of ordinary skill in the art would be motivated to formulate the claimed compound from the disclosure of the alkanolamides taught by Hohn-Stocker et al due to the similarity in chemical structure and expectation that the claimed compounds will possess similar properties. The claimed compounds are higher homologs of the compounds taught by the prior art in that they differ by only one methyl group. A rejection based on close structural similarity is founded on the expectation that compounds similar in structure will have similar properties. An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties. In re Payne, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA 1979). See MPEP 2144.09.

The thickening agents are compatible with almost all surface-active compounds typically used in cosmetics, hair and skin care and domestically and in industry for cleaning purposes and in he sanitary sector. The compounds can be used individually or as mixtures and are compatible with anionic, nonionic, and amphoteric surfactants such as alkyl sulfates, alkyl ether sulfates, etc. See column 2, lines 55-65.

Librizzi teaches a cleaning composition which is mild to the skin and eyes which includes a fatty monoethanolamide compound and at least one anionic surfactant. The composition may also include nonionic, amphoteric, betaine, and cationic surfactants. The compositions are useful as shampoos, washes, baths, gels, etc. Librizzi teaches alkanolamides which have a similar structure to those recited by the instant claims.

See Abstract. Note that, the Examiner asserts that one of ordinary skill in the art would be motivated to formulate the claimed compound from the disclosure of the alkanolamides taught by Librizzi due to the similarity in chemical structure and expectation that the claimed compounds will possess similar properties. The claimed compounds are higher homologs of the compounds taught by the prior art in that they differ by only two methyl (alkylene) groups. A rejection based on close structural similarity is founded on the expectation that compounds similar in structure will have similar properties. An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties. In re Payne, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA 1979). See MPEP 2144.09.

Suitable anionic surfactants include alkyl sulfates, alkyl ether sulfates, alkyl ether carboxylates, etc. See column 2, lines 20-50.

'153 teaches a liquid detergent composition suitable for dishwashing by hand containing an anionic detergent, alkyl ether sulphate, a lather booster which is an alkanolamide, dialkanolamide, betaine or amine oxide, and a nonionic detergent. See Abstract. Suitable nonionic surfactants include ethoxylated alkanolamides which have a similar structure to the compounds recited by the instant claims. See page 18, lines 5-20. Note that, the Examiner asserts that one of ordinary skill in the art would be motivated to formulate the claimed compound from the disclosure of the alkanolamides taught by '153 due to the similarity in chemical structure and expectation that the

claimed compounds will possess similar properties. The claimed compounds are higher homologs of the compounds taught by the prior art in that they differ by only one methyl group. A rejection based on close structural similarity is founded on the expectation that compounds similar in structure will have similar properties. An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties. In re Payne, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA 1979). See MPEP 2144.09.

Hohn-Stocker et al (US 6,172,035), Librizzi (US 6,514,918), or EP 232,153 do not teach, with sufficient specificity, a thickener comprising a fatty acid alkanolamide compound or detergent composition containing such a compound and surfactant as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a thickener comprising a fatty acid alkanolamide compound or detergent composition containing such a compound and surfactant as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of Hohn-Stocker et al (US 6,172,035), Librizzi (US 6,514,918), or EP 232,153 suggest a thickener comprising a fatty acid alkanolamide compound or detergent composition containing such a compound and surfactant as recited by the instant claims.

Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/46356 as applied to claims 1 and 2 above, and further in view of Librizzi (US 6,514,918).

'356 is relied upon as set forth above. However, '356 does not specifically teach the use of anionic surfactants in addition to the alkanolamide compound as recited by the instant claims.

Librizzi is relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use an anionic surfactant in the compositions taught by '356 containing an alkanolamide compound, with a reasonable expectation of success, because Librizzi et al teaches the use of alkanolamide compounds in combination with anionic surfactants in shampoo and personal use compostions and '356 teaches the use of alkanolamide compounds in shampoo compositions which generally contain surfactants.

Conclusion

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less pertinent than those relied upon or discussed above.

Applicant is reminded that any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory R. Del Cotto
Primary Examiner
Art Unit 1751

GRD
October 6, 2004